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In re Application of:	:	
ALEXANDROV et al.	:	DECISION ON
US Application No.: 09/869,181	:	
PCT Application No.: PCT/UA00/00035	:	PETITION UNDER
Int. Filing Date: 05 October 2000	:	
Priority Date: 22 October 1999	:	37 CFR 1.47(A)
For: LUBRICANT COMPOSITION	:	

This is a decision in response to applicant's petition under 37 CFR 1.47(a) filed on 21 June 2001.

BACKGROUND

On 05 October 2000, applicants filed international application PCT/UA00/00035, which designates the U.S. and claims a priority date of 22 October 1999. Accordingly the 20-month deadline for entry into the U.S. national stage expired at midnight on 22 June 2001.

On 21 June 2001, applicant filed in the United States Patent and Trademark Office (USPTO) a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite U.S. Basic national fee, a declaration signed by four of the five applicant/inventors named in PCT/UA00/00035, and a petition under 37 CFR 1.47(a) requesting acceptance of the application without the signature of applicant Vladimir Valentinovich Buzov.

DISCUSSION

A petition pursuant to 37 CFR 1.47(a) to accept the application without the signature of one of the joint inventors must include: 1) an oath or declaration signed by all available joint inventors on their own behalf and on behalf of the nonsigning inventor; 2) proof that the nonsigning inventor refuses to join in an application for patent or cannot be found or reached

after diligent effort; 3) the petition fee; and 4) the last known address of the nonsigning inventor.

Petitioners have satisfied items (1) and (3).

With regard to item (4), the petition does not indicate inventor Buzov's last known address.

With regard to item (2), the petition does not include sufficient proof that a bona fide attempt was made to present a copy of the application papers to the nonsigning inventor. In addition, the petition does not include sufficient proof that, after diligent effort, the inventor could not be reached at his last known address. MPEP 409.03(d) states:

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. . . . Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions. . . .

A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . .

The petition states that a Ukrainian patent attorney, Ms. Alla Sergeevna Seryugina, "has advised us that Mr. BUZOV has renounced all of his authorship and property rights in any applications that result from filing of the priority Ukraine Patent Application 99105787; that he refused to sign any additional documents in connection with the subject matter of the application

at the time he renounced his authorship and property rights in the priority Ukraine patent application; and that he cannot be reached."

The petition does not allege that inventor Buzov was provided with a copy of the application papers (specification, including claims, drawings, and oath or declaration) and the petition presents no proof that such a presentation was made. The petition does not indicate the circumstances of the presentation of the application papers and of the refusal of inventor Buzov to sign same. No statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made is presented in the petition.

With regard to the issue that inventor Buzov "cannot be reached," it is noted that there is no indication in the petition that a bona fide effort was made to reach inventor Buzov to request his signature on the application papers. No facts are presented in the petition regarding any efforts made to reach inventor Buzov, thus a conclusion that inventor Buzov could not be reached is not supported by the petition.

The Ukrainian document provided with the petition appears to be an assignment document assigning inventor Buzov's rights in the invention to the remaining four inventors. This document is not proof under 37 CFR 1.47(a) that inventor Buzov refused to sign the application papers or that he could not be reached. Indeed, the Ukrainian document would appear to support a conclusion that inventor Buzov could be reached to sign documents.

DECISION

For the reasons discussed above, applicant's request that the United States Patent and Trademark Office accept this application without the signature of applicant Vladimir Valentinovich Buzov is **DISMISSED**, without prejudice.

Applicants are hereby afforded **TWO (2) MONTHS** from the mail date of this decision to provide either a declaration in compliance with 37 CFR 1.497(a)-(b) signed by all inventors or a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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